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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,534	12/19/2003	Brett Rimmer	56.0719	1533
27452 7590 05/14/2007 SCHLUMBERGER TECHNOLOGY CORPORATION David Cate IP DEPT., WELL STIMULATION 110 SCHLUMBERGER DRIVE, MD1 SUGAR LAND, TX 77478			EXAMINER FIGUEROA, JOHN J	
			ART UNIT 1712	PAPER NUMBER
			NOTIFICATION DATE 05/14/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/707,534

Applicant(s)

RIMMER ET AL.

Examiner

John J. Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The 35 USC 112, first paragraph, rejection of claims 1 and 3-15 of record in item 2 on page 2 of the Office Action of November 29, 2006, hereinafter 'OA,' has been withdrawn.

2. The 35 U.S.C. 103(a) rejection of claims 1, 3-5 and 7-13 (item 4 on page 3 of OA) as unpatentable over United States Patent Number (USPN) 6,655,475 B1 to Wald (hereinafter 'Wald') in view of USPN 4,790,386 to Johnson (hereinafter 'Johnson') has been withdrawn in view of Applicant's amendment to the claims in the response to OA filed February 27, 2007, hereinafter 'Response'.

3. The 35 U.S.C. 103(a) rejection of claims 1, 3-5 and 7-12 as unpatentable over USPN 4,846,279 to Bruce (hereinafter 'Bruce') in view of Johnson has been maintained for reasons previously made of record in item 5 on page 6 of OA and set forth below in paragraph #9 of the instant Action.

4. The 35 U.S.C. 103(a) rejection of claims 1, 4 and 6-12 as unpatentable over USPN 3,104,716 to Burkhardt et al. (hereinafter 'Burkhardt') in view of Johnson of record in item 6 on page 8 of OA has been withdrawn in view of Applicant's amendment to the claims in Response.

5. The 35 U.S.C. 103(a) rejection of claims 1 and 13-15 as unpatentable over USPN 6,387,986 B1 to Moradi-Araghi, hereinafter 'Moradi' in view of Bruce and

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Johnson (as applied in paragraph #3 above) has been maintained for reasons previously made of record in item 7 on page 10 of OA.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1, and claims 3-15 that depend therefrom, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for introducing a chemical in a reusable or refillable container, it does not reasonably provide enablement for providing said chemical in a "non-degradable" container".

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Paragraph [0018] of the specification discusses refilling the container (albeit in a non-preferred embodiment) and paragraph [0026] teaches replenishing the container(s). However, the specification does not provide sufficient disclosure to enable the method of delivery recited in the instant method claims to comprise providing the chemical into the path of production fluids "in a *non-degradable*, meshed or mesh-like basket container." A container that can be replenished or reused is not necessarily a container that is non-degradable. For example, a refillable container may gradually degrade over time after several uses.

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Although Applicant is correct that the subject matter of the claim need not have to be described in *haec verba* in order for the disclosure to satisfy the description requirement (Response, page 6, lines 9-27 citing *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320 (Fed. Cir. 2000)), and that there is sufficient disclosure in the specification to enable for a mesh-like basket container that can be replenished and/or reused, there is insufficient written description support in the instant specification for a meshed or mesh-like basket container that does not degrade over time after various uses.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Amended claims 1, 3-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce in view of Johnson.

Applicant has amended independent claim 1 to limit the chemical to be introduced into the path of production fluids "in a *non-degradable*, meshed or mesh-like basket container ... which produced fluids can flow without being significantly impeded."

Johnson and Bruce were discussed previously in items 4 and 5 of OA, respectively, and the arguments and grounds of rejection therein regarding the instant claims are incorporated herein in their entirety.

Bruce discloses that the canister may be of any size and that it can be formed from stainless steel or titanium (non-degradable materials) that can have a service life

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of at least several months. (Col. 3, lines 37-40; col. 4, lines 33-60) In addition, Bruce discloses several apertures may be provided in the bottom wall or sidewall of the canister allowing for the manipulation of the fluid pressure within the canister, thus permitting (in one embodiment) for the produced fluids to flow without being "significantly" impeded. (Col. 3, lines 41-63; col. 5, lines 25-44)

Thus, the claims as amended, remain unpatentable over Bruce in view of Johnson.

10. Claims 4, 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce in view of Johnson, as applied to claims 1 and 4 above in paragraph #9 of the instant Office Action, and further in view of Burkhardt.

Applicant's amendment to independent claim 1 has been discussed above in the immediately preceding paragraph.

Bruce and Johnson were discussed above in paragraph #9. Neither Bruce nor John expressly discloses the production tubing provided with a nipple.

Burkhardt was discussed previously in item 6 of OA and all the arguments and grounds of rejection therein regarding the instant claims are incorporated herein in their entirety.

Burkhardt teaches that the container 37 in Figure 1 (used in the method for delivering a corrosive inhibitor into a well bore 10) is anchored in the lower end of production tubing 16 by a landing nipple 18 that receives extension tubing 20 provided with packer 22 (which sits in said landing nipple 18 when extension tubing 20 is lowered) thus provide anchoring means for the container. (Col. 1, lines 23-45; col. 2,

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lines 1-13 and 18-24; col. 3, lines 51-62; Figures 1 and 5-6) The extension tubing 20 (including the container) may be lowered by conventional means, such as a wire line attachable to fishing neck 26, and the bottom of production tubing 16 is provided with plug 38 to form the reservoir of container 37 which encloses the corrosion inhibitor. (Col. 2, lines 14-17 and 34-38; col. 3, lines 51-54) For example, by anchoring the container upwardly in the production tubing for a substantial distance (and time), a large supply of corrosion inhibitor can be supplied on to the casing and tubing walls thus providing a more uniform and effective treatment. (Col. 2, lines 34-38; claim 2; Figure 1)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to anchor the container disclosed in Bruce and Johnson at one end of the production tubing via, *inter alia*, a landing nipple. It would have been obvious to do so to provide a larger supply of treatment over a longer period of time and attain a more effective treatment distribution of the well bore's metal casing surfaces as taught by Burkhardt.

Thus, the instant claims, as amended, are unpatentable over Bruce, Johnson and Burkhardt.

Response to Arguments

The 35 U.S.C. 112 Rejection (item 2 on page 2 of OA)

11. Applicant's arguments filed regarding the captioned 35 U.S.C. 112, first paragraph, rejection of claims 1 and 3-15 have been considered but deemed moot due to the withdrawal of this rejection in view of the following disclosures in the specification.

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Paragraph [0013] of the instant specification discloses a mesh-like basket having apertures of relatively high dimension so that the flow of production fluids is not significantly impeded (providing support for a solid, slow release form because if the chemical was liquid, it would spill right out of the basket); whereas paragraph [0023] discloses scale inhibitors as porous ceramic particles that can be considered as "solid."

The 35 U.S.C. 103 Rejection over Wald and Johnson (item 4 on page 3 of OA)

12. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection as unpatentable over Wald in view of Johnson have been fully considered but have become moot in view of the new grounds of rejection caused by Applicant's amendment to claim 1 limiting the container to be "non-degradable". (Neither Wald nor Johnson expressly disclose the container to be non-degradable.)

However, this new limitation of the current amendment to independent claim 1 ("non-degradable" container) has been rejected above in paragraph #7 as new matter that does not have written description support in the instant specification. Examiner notes that the captioned rejection will be reinstituted if Applicant removes said limitation from the instant claims.

The 35 U.S.C. 103 Rejection over Bruce and Johnson (item 5 on page 6 of OA)

13. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 1, 3-5 and 7-12 as unpatentable over Bruce in view of Johnson have been fully considered but deemed unpersuasive.

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In response to Applicant's arguments that Bruce does not disclose the chemical released from the container to be solid, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The instant rejection is a 35 U.S.C. 103 over Bruce **and** Johnson, not a rejection over Bruce alone. As discussed previously in item 5 of OA, which on page 7, lines 12-13, refers back to the discussion of Johnson in item 4):

"Johnson teaches a method of delivering a treatment composition ("chemical") into a well bore ... providing a container ("basket") loaded with the treatment composition ... wherein the treatment composition is gradually released into the well bore at a desired rate. ... Johnson also teaches that the treatment composition can be any chemical suitable for inhibiting scale, wax and/or corrosion of metal surfaces in the well bore. (Col. 4, lines 16-20) For example, *the composition that is gradually introduced into the well can be a semi-solid composition, a polymer solution and/or an inhibitor*, wherein said polymer solution can comprise an inhibitor and said inhibitor can be a polyacrylate, poly(meth)acrylate, polyacrylamide or alkaline salts of phosphate (includes organic and inorganic), phosphorate, acrylates (a carboxylate) or sulfonate. (Col. 4, lines 25-30; col. 6, lines 22-32) Johnson further teaches that the top of the container can comprise an open-mesh screen if necessary to restrain the movement of the treatment composition from the top of the container. (Col. 5, lines 21-27; col. 6, lines 33-42) The open mesh screen can be attached over an opening/aperture of the container if necessary to restrain the treatment composition against its movement out through an opening or aperture of the container. (Col. 5, lines 20-27)" [Pages 4 and 5 of OA, Emphasis added.]

Therefore, Johnson is teaching that an open mesh screen can be added to an opening of a container (such as the *at least one* aperture, which can be several, in the canister used in Bruce's method of treating a well bore) that can restrain any type of

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treatment composition as, e.g., a solid, slow release chemical inhibitor composition, thereby providing an enhanced resultant method of treatment that can deliver various types of scale/corrosion inhibitor chemicals to the side walls of the production tubing of a well bore:

Similarly, Applicant's argument that the container in Bruce would "significantly" impede production fluids is inaccurate. As discussed above and previously in item 5 of OA:

"Bruce discloses treating a well bore by locating a canister at the bottom portion of a well bore, said canister (container) having a bladder that includes a chemical treating composition that flows into the production fluid by pressure differentiation, wherein the flow rate of delivery of the composition into the well can be controlled and predetermined. (Abstract; Figures 1 and 2; col. 2, lines 18-30 and 42-54) The canister ... can be ... made from stainless steel, titanium or similar materials that can withstand the physical stresses to which it is exposed and resist attack from corrosive well fluids (so that it can be reused) and thus perform satisfactorily during its entire design life. (Col. 2, lines 51-54; Col. 3, lines 4-40; col. 4, lines 40-59) ... Bruce further discloses *that the bottom of the canister may contain at least one aperture, on its bottom wall or on its side, through which the well fluid can enter thereby*, subjecting the inner bladder to the fluid pressure existing at the bottom portion of the well. (Col. 3, lines 41-62) The flow rate *can also be* severely restricted allowing for the canister to be located at a higher point in the well bore and thus, anchored alongside the sidewall of the well bore. (Col. 4, lines 60 to col. 5, line 2; col. 5, line 55 to col. 6, line 25; Fig. 2)" [Pages 6 and 7 of OA; Emphasis Added]

Accordingly, Bruce is expressly disclosing that the container can have several apertures through which the production fluids of the well can enter, thereby not "significantly" impeding the flow of production fluids through the container.

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Thus, the instant claims, as amended, remain unpatentable over Bruce and Johnson.

The 35 U.S.C. 103 Rejection over Burkhardt and Johnson (item 6 on page 8 of OA)

14. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 3 and 5 over Kuegermann have been considered but have become moot in view of the new grounds of rejection caused by Applicant's amendment to claim 1 requiring the produced fluids to flow through the container "without being significantly impeded." The apparatus for injecting treating compositions into a well that is taught by Burkhardt comprises a container having a permeable member that prevents produced oil from entering the container.

The 35 U.S.C. 103 Rejection over Moradi, Bruce and Johnson (item 7 on page 10 of OA)

15. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 1 and 13-15 over Moradi in view of Bruce and Johnson have been fully considered but deemed unpersuasive.

Examiner notes that Applicant did not address in Response the particular grounds of rejection regarding Moradi, Bruce and Johnson except to mention on page 7 that Moradi-Araghi "does not address the missing limitations ... with respect to ... Bruce ... in view of Johnson." However, as shown above in the instant Action regarding the grounds of rejection of Bruce in view of Johnson (paragraph #13), this combination does obviate the rejected claims, as amended.

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Regarding Moradi in particular, as discussed in item 7 on page 10 of OA, Moradi does disclose encapsulating crosslinking agents and gel-forming chemicals to be used in oil-field compositions. (Page 10, lines 7-8). Bruce and Johnson teach an effective method of delivering oil-filled chemical compositions into a well bore over a preferred, extended period of time. Accordingly, as explained in item 7 of OA, it would have been obvious to one in the art to provide the encapsulated chemical treatment compositions disclosed in Moradi into a production casing of a well bore using the efficient delivery system taught by Bruce and Johnson.

Thus, the instant claims, as amended, remain unpatentable over Moradi, Bruce and Johnson.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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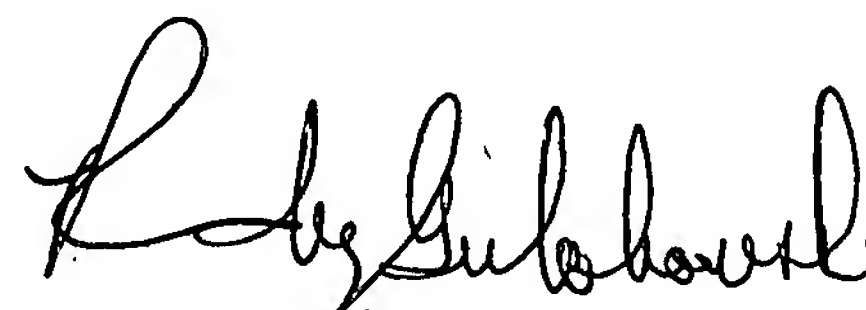
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



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